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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,562	03/29/2001	Gilbert Bloch	82017-3700	4962

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WINSTON & STRAWN
200 Park Avenue
New York, NY 10166-4193

EXAMINER

ZIRKER, DANIEL R

ART UNIT PAPER NUMBER

1771

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 10/17/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 16-30 is/are pending in the application.
 - Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 16-30 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 16-30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, despite the addition of a newly drafted set of claims for the original claims in the application, the claims as they exist appear to contain a great number of informalities and other related problems. The Examiner will attempt to identify as many as possible, however, others may exist and applicants are encouraged to correct them. In claim 16, line 1, "lamine" is not understood inasmuch as throughout the application applicants, except for a brief recitation of their title directed to "pressure sensitive paper plastic film laminate tape" is directed to a "pressure sensitive sealing tape". Additionally, in the last three lines of claim 16 the references (line 6) "to the various articles" is not understood since applicants appear to nowhere be claiming an article in combination with the "lamine" i.e. sealing tape. In claim 20, line 2 it appears proper to characterize the "polymer" as a --polymer film--, and in claim 21 in view of applicants' remarks throughout the prosecution such as in the Declaration of Mr. Finestone it is not understood why the claim need exist in view of the fact that "cold lamination" is believed to encompass such

an embodiment. In claim 22, line 3, it is suggested to delete "composition". In claim 24, lines 2 and 3, the various Markush elements are believed improperly recited, i.e. instead of "a rubber" it is suggested to use "--rubber based adhesive--", and likewise similar terminology is suggested for the remaining claims. ^{elements} In claim 25, line 2, the recitation in two places of "un-laminated" lacks antecedent basis. In claim 27, lines 3 and 4, it again appears that it is unclear whether or not the "article" is part of the genus being claimed. In claim 28, the presence of "unlaminated" in two places is again believed improper, and the Examiner further questions whether corona discharge treatments are utilized to render said surface receptive to inks, ^{as} it is noted that the only place in the original specification this finds support is in now cancelled claim 13. Clarification is requested.

3. Claims 16-22 and 24-30 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. More particularly, as has been previously set forth it is believed that applicants' disclosed enablement such as is set forth in his specification (e.g. claim 1, at the Summary of the Invention) wherein the outer adhesive layer is a pressure sensitive adhesive layer appears to be critical or essential to the practice of the invention, but not included in the claim(s)

is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

4. Claims 16-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Williams -877 or Williams -971, each taken in view of Ohno et al., substantially for the reasons set forth in paragraph No. 3 of the final rejection, together with the following additional observations. The Examiner again repeats his contention that "cold lamination" is a product-by-process limitation which has not yet been shown on the record to produce a patentably distinct article from those articles which are relied upon in the Examiner's two prior art combinations. Although it is noted that the Finestone Declaration argues quite extensively a great number of alleged differences between the utilization of cold lamination as being superior over the prior art combination embodiments relied upon by the Examiner, (e.g. paragraphs Nos. 11 and 8, as well as others) to date there has been no valid comparison against the "closest prior art" i.e. against suitable embodiments taken from the relied upon prior art combinations which the Examiner has relied upon. With respect to applicants' arguments against the prior art rejections, the Examiner believes that the Williams patents are each combinable with the Ohno et al. patent, with the references each being taken from the multilayer adhesive tape art. For example, note the titles of the three references as all

referring to adhesive tapes. Applicants' contention that the primary and secondary references are "non-analogous art" (Response, page 2, last paragraph) is not seen to be a proper analysis of the law with respect to whether or not references can be combined, particularly when a clear case for proper motivation for their combination has been established. Stated perhaps differently, the Examiner believes that the field of combinable prior art is much broader than that which applicants would appear to believe. Note also that Ohno et al. expressly teaches the utilization of corona discharge techniques (column 3 lines 17-18), and which is believed to rebut applicants' arguments (Response, paragraph bridging pages 1 and 2) as being a patentable feature. Additionally, it is further noteworthy that applicants are believed to have admitted during the prosecution that corona discharge techniques have been well known in the adhesive tape art for some time prior to the invention of "cold lamination". In summary, it is believed that without a suitable comparative Declaration applicants have again failed to rebut the prima facie case of record.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

December 16, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1000~~
1700

Daniel Zinker